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| 22850 7590 06/15/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | | |
| EXAMINER REAGAN, JAMES A | | | | |
| ART UNIT 3621 | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/680,381

Applicant(s)

SHIRAI ET AL.

Examiner

JAMES A. REAGAN

Art Unit

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-24 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-24 and 34-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 08 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date 03/16/2010
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the RCE filed on **05/07/2010**.
2. Claims 1, 2, 12, and 16 have been amended.
3. Claim 37 has been added.
4. The rejections of claims 1-4, 6-24, and 34-37 has been updated to reflect the amended limitations.
5. Claims 1-4, 6-24, and 34-37 are currently pending and have been examined.

Information Disclosure Statement

6. The Information Disclosure Statement filed on **03/16/2010** has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Response to Arguments

7. Applicant's arguments received **05/07/2010** have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.
8. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1, 8, 10, 12, 19, and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
11. Claims 1, 8, 10, 12, 19, and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner cannot determine the metes and bounds of the claim because the claim has been written in the alternative using an "or" statement. For the purposes of this examination, the Examiner will assume that the claim is a properly written Markush-type limitation: *...one of the group consisting of [A, B, and C].*

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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15. Claims 1-4, 6-24, and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik (USPGP 2005/0086172 A1), hereinafter **STEFIK**, in view of Breiter et al. (USPGP 2003/0079133 A1), hereinafter **BREITER**.

Claim 1:

STEFIK as shown below discloses the following limitations:

- *a communication unit for executing communication processing with a license storage device storing rights information serving as usage rights information of contents associated with a user of the information processing device, and communication processing with a contents distribution server; (see at least Figures 1-4b as well as associated and related text)*
- *an encryption processing unit for executing encryption processing including authentication processing in said communication processing; (see at least paragraph 0056)*
- *a control unit for executing processing control for inputting rights information corresponding to contents from said license storage device, via said communication unit, transmitting said input rights information, which indicates rights to receive streaming contents, to said contents distribution server, and receiving streaming contents set corresponding to said transmission rights information from said contents distribution server and playing or using said streaming contents, the control unit stopping the playing or the using of said streaming contents when a subsequent authentication processing, conducted when the information processing device is receiving said streaming contents, fails (see at least Figures 1-4b as well as associated and related text; Figure 15 as well as associated and related text; Figures 16-19 as well as associated and related text)*

STEFIK discloses downloading of digital files and data but does not specifically disclose streaming data. In addition, **STEFIK** discloses content repositories, digital rights, and licenses, but does not specifically disclose a license server per se. **BREITER**, however, in at least paragraph 0012 discloses licenses provided through servers, and in paragraph 0039 discloses streaming data through the Internet. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine/modify the DRM method of **STEFIK** with the online licensing and streaming technique of **BREITER** because this enables, "...the prevention of uncontrollable downloads through the network within P2P (point to point) scenarios, such as Napster, and also unauthorized duplication of content on media, such as CD or DVD." (**BREITER**: paragraph 0004)

Claim 2:

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses *said encryption processing unit has a configuration for executing verification processing for a tampering verification value attached to contents-corresponding rights information input from said license storage device, said encryption processing unit executing authentication processing at least once while the information processing device is receiving said streaming contents*. See at least paragraph 0363.

Claim 3:

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses:

- *said encryption processing unit executes mutual authentication with said license storage device;*
- *wherein said control unit has a configuration for executing input processing of contents-corresponding rights information input from said license storage device*

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via said communication unit, with the establishment of said mutual verification as a precondition thereof.

See at least paragraphs 0362 and Figures 1-4b as well as associated and related text.

Claim 4:

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses:

- *said encryption processing unit has a configuration for executing mutual authentication and key-sharing processing with said license storage device, and for executing verification processing for a tampering verification value attached to contents-corresponding rights information input from said license storage device via said communication unit, applying a key generated in said key-sharing processing.*

See at least paragraphs 0356, 0362, and 0363.

Claim 6:

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses:

- *said encryption processing unit has a configuration for executing mutual authentication and key-sharing processing with said contents distribution server, and for executing verification processing for a tampering verification value attached to a contents file from said contents distribution server via said communication unit, applying a key generated in said key-sharing processing.*

See at least paragraphs 0356, 0362, and 0363.

Claim 7:

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses:

- *said encryption processing unit has a configuration for executing mutual authentication and key-sharing processing with said contents distribution server, and for executing decryption of an encrypted contents encryption processing key attached to a contents file from said contents distribution server via said communication unit, applying a key generated in said key-sharing processing.*

See at least paragraphs 0356, 0362, and 0363.

Claim 8:

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses:

- *header information of a contents file received from said contents distribution server contains RHD check mode information setting whether or not to take connection with said license storage device at the time of playing contents as a precondition thereof;*
- *wherein said encryption processing unit executes mutual authentication processing with said license storage device for contents playing processing wherein said RHD check mode information takes connection with said license storage device at the time of playing contents as a precondition thereof;*
- *wherein said control unit performs contents playing processing with establishment of said authentication as a precondition thereof.*

See at least paragraphs 0108, 0450, 0356, 0362, and 0363; Figure 15 as well as associated and related text.

Claim 9:

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses:

- *header information of a contents file received from said contents distribution server contains output control information of contents;*
- *wherein said control unit executes output control of contents following said output control information.*

See at least paragraphs 0108, 0450, 0356, 0362, and 0363; Figure 15 as well as associated and related text.

Claim 10:

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses:

- *said rights information contains contents distribution server information or index server information of a server capable of providing streaming contents corresponding to said rights information;*
- *wherein said control unit is of a configuration for executing processing for deciding a connection destination based on said contents distribution server information or said index server information.*

See at least paragraphs 0108, 0450, 0356, 0362, and 0363; Figure 15 as well as associated and related text.

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Claim 11:

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses *control unit is of a configuration for executing processing for transmitting, to a contents distribution server providing contents, specs information including data format information of data formats playable at the information processing device serving as a contents using device, along with said rights information.* See at least paragraphs 0108, 0450, 0356, 0362, and 0363; Figure 15 as well as associated and related text.

Claims 12-24 and 34-37:

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. The Examiner finds that remaining claims 12-24 and 34-37 are not patentably distinct from claims 1-4 and 6-11 and therefore, for the sake of clarity, has grouped the rejections of claims 1-4, 6-24, and 34-37 accordingly using the same references and citations as above.

Conclusion

16. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **ANDREW J. FISCHER** can be reached at **571.272.6779**.
17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
18. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to **571-273-8300**.

19. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building
401 Dulany Street
Alexandria, VA 22314.

/James A. Reagan/

Primary Examiner, Art Unit 3621